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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/834,812	04/13/2001	Shuichi Kikuchi	450100-03161	8677
20999	7590	02/10/2004		
FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151				
			EXAMINER MILLER, BRIAN E	
			ART UNIT	PAPER NUMBER

2652

DATE MAILED: 02/10/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/834,812

Applicant(s)

KIKUCHI, SHUICHI

Examiner

Brian E. Miller

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,4-10 and 16-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 8-10 is/are allowed.
- 6) ☒ Claim(s) 2, 4-7, 16-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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Claims 2, 4-10, 16-19 are now pending.

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/16/04 has been entered.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

3. Claims 2, 4-7, 16-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. (a) Claim 16 recites language and limitations which are not directed to a shutter, e.g., elongate opening, one opening being more elongate than the opening on the other side, etc., therefore, since the preamble sets forth "A metal shutter", the metes and bounds of the claim is not readily ascertained by the Examiner, since the aforementioned opening(s) are not encompassed by a shutter.

Claim Rejections - 35 USC § 103

4. Claims 2, 4, 7, 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takeda et al (US 5,308,708) in view of Kikuchi et al (JP 10-162541). In so far as the claims are definite and understood, Takeda et al discloses a stainless steel metal shutter (FIG. 5) for a disc cartridge which includes a plastic enclosure and disc medium (col. 1, lines 13-22), further including: a screen portion having inside and outside surfaces B, C (FIG. 5) having an indication area on the outside surface B, the indication area including a rough surface portion, i.e., having a surface roughness, and an inside surface thereof C; having another rough surface area (see col. 4, lines 17-25 and 44-58); wherein the shutter has a thickness between 0.15 mm and .5 mm, i.e., 0.2 mm (see col. 8, line 54) (re claim 2); wherein the roughness of the inside surface is less than the roughness of the outside surface (see Table 2); wherein the indication area B is provided on a flat portion of the screen portion; such that the shutter is also considered to include the "screen portion...with an indication area" and a rough surface part "configured to constitute a given pattern," as no structural limitations have been set forth.

Takeda et al is silent as to the shutter being elongated and to the material being aluminum.

Kikuchi et al discloses a disc cartridge with an aluminum metal shutter, such that the aluminum substrate 11 has a thickness between 0.15-0.5mm (see paragraph [0046]) (re claim 2) and the cartridge includes elongated openings, one longer than the other; the shutter comprising a longer rectangular portion and a shorter rectangular portion with a interconnecting edge portion (see FIG. 19). From these teachings, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have utilized aluminum in place of stainless steel and to have modified the shape of the shutter to have one longer rectangular portion. Lacking any

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unobvious or unexpected results, the motivation would have been: aluminum would have been a recognized substitution for stainless steel and the shape of the shutter being elongated would have resulted through routine engineering optimization and experimentation, and as taught by Kikuchi (JP '541). Furthermore, a change in shape/form has been held to involve only routine skill; see *In re Dailey*, 149 USPQ 47 (CCPA 1976).

Allowable Subject Matter

5. Claims 8-10 are allowable over the prior art. Reasons for allowance will be set forth upon allowance of the application.

6. Claims 5-6 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Response to Amendment

7. Applicant's arguments filed 1/16/04 have been fully considered but they are not persuasive.

A...Applicant asserts with regard to the 102 rejection to Kikuchi (JP 10-162541) that with the amendments to the claims including a "stamped rough surface part which is configured to constitute a given pattern" is not taught or suggested by the reference to Kikuchi et al.

While the amended claims overcome the aforementioned 102 rejection, the Examiner maintains that they do not overcome the 103 rejection of Takeda (US 5,308,708) in view of Kikuchi (10-162541).

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B...With respect to the 103 rejection, applicant asserts that Takeda does not disclose an aluminum shutter (which was established by the Examiner), and “It is not seen where the abstract of this Japanese publication makes such a disclosure.”

Specifically, the Examiner had pointed to paragraph [0046] in the disclosure (not the abstract as stated by applicant) of Kikuchi et al which states in part (from a machine English translation) “In addition, although the example shown in the drawing showed the case where aluminum sheet metal with a thickness of 0.3mm was used for the shutter substrate 11, although the thickness of the shutter substrate 11 is not limited to 0.3mm, the range which is 0.15-0.5mm is desirable [thickness].”

This disclosure was considered sufficient teaching to suggest (to a skilled artisan) changing the material from stainless steel to aluminum.

C...Applicant fails to direct any further arguments to the applied prior art with respect to the newly added language. In view of the broad recitations of “is configured to constitute a given pattern” and “at a portion corresponding to said indication area with another rough surface area” in these new limitations, it is considered that the teachings of Takeda et al encompass these limitations as well.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian E. Miller whose telephone number is (703) 308-2850. The examiner can normally be reached on M-TH 7:15am-4:45pm (and every other friday).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa T. Nguyen can be reached on (703) 305-9687. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4750.

A handwritten signature in black ink, appearing to read "B. E. Miller", is written over a horizontal line.

Brian E. Miller
Primary Examiner
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bem
January 29, 2004